

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS & AMENDMENTS

Kindly clarify the status of the pending and rejected claims. It appears that claim 39 was omitted from the list of pending and rejected claims in items 4 and 6 on page 1 of the Office Action.

Claims 7, 20, 21, 33, 39, 40 and 42-46 were pending in this application when last examined.

Claims 21, 33, 39, 40 and 42-46 were rejected.

Claims 7 and 20 were indicated as allowed.

Claims 44-46 have been cancelled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

Support for the amendment to R¹ in claims 21, 33, 39 and 40 can be found at page 30, lines 5-9.

Support for the amendment to R² in claims 21, 33, 39 and 40 can be found at page 32, lines 19-21.

Support for the amendment to R³ in claims 21, 33, 39 and 40 can be found at page 34, lines 5-8.

Support for the amendment to R⁴, ring A and ring B of claims 21, 33, 39, 40 and 43 can be found in the claims as filed.

Support for new claims 47-49 can be found at page 51, lines 15-16.

Therefore, no new matter has been added by this amendment.

Claims 7, 20, 21, 33, 39, 40, 42-43 and 47-49 are pending upon entry of this amendment.

II. ENABLEMENT REJECTION

On pages 2-3 of the Office Action, claims 21, 33, 39, 40 and 42-46 were newly rejected under 35 U.S.C. § 112, first paragraph on the basis that the specification lacks enablement for all of the instantly claimed melatonin receptor agonists, because the heterocyclic groups in R³ and the hydrocarbon carbons in R¹, R² and R³ are overly broad.

This rejection is respectfully traversed as applied to the amended and new claims.

The test of enablement is whether one reasonably skilled in the art could make or use the invention based on the disclosure in the specification coupled with the knowledge in the art without undue experimentation. The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. The test is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. See M.P.E.P. § 2164.01.

On page 3 of the Action, it was suggested that the claimed compounds be amended to compounds which are “closely related” in structure and size, polarity and electronegativity to the melatonin receptor agonist exemplified in the specification. It is respectfully submitted that the claims have been as suggested by the Examiner to compounds which are “closely related” to the compound indicated as enabled, *i.e.*, instant experimental compound A. At page 81, lines 10-12, the specification demonstrates the effectiveness of compound A.

It is respectfully submitted that this working example is representative of the compounds of the amended claims.

In addition, on pages 13-17 of the specification, numerous other compounds are disclosed with melatonin receptor agonist activity. These structures provide sufficient guidance to enable the skilled artisan to make and use other melatonin receptor agonists based on the structures in amended claims 21, 33, 39 and 40 and the new claims.

Thus, it is respectfully submitted that one of skill in the art would be able to make and use the compounds of the amended and new claims without undue experimentation given the guidance in the specification and the working example.

In view of the above, the enablement rejection of claims 21, 33, 39, 40 and 42-46 under 35 U.S.C. § 112, first paragraph, is untenable and should be withdrawn.

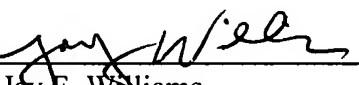
CONCLUSION

In view of the foregoing amendments and remarks, the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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